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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,035	01/09/2006	Oliver Schaefer	WAS0740PUSA	1674

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EXAMINER	
PENG, KUO LIANG	
ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
06/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/595,035	SCHAEFER ET AL.	
	Examiner	Art Unit	
	Kuo-Liang Peng	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *4/24/06 IDS*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/24/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Applicants' preliminary amendment filed January 9, 2006 is acknowledged. Claims 1-10 are deleted. Claims 11-24 are added. Now, Claims 11-24 are pending.

2. Applicant is advised that should Claim 14 be found allowable, Claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re*

Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 20 of copending Application No.10/595,036. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: Claim 20 of the copending Application is directed to a functionalized organopolysiloxane which obviously read on the compositions of the present invention. Notably, the resin of the copending Application, which is substantially the same as the material in the present invention, can obviously be characterized as elastomeric and antistatic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 11 (line 7 from bottom), "alone" causes confusion because k+m+p+q must be at least 1.

Claim 12 is indefinite because of the similar reason set forth above in Claim 11.

In Claim 24 (line 1), should "claim 21" be -- claim 23 --?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11-13, 16, 18 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fekete (US 3 019 248).

For Claims 11-13 and 18, Fekete discloses a process for preparing a phosphonate-modified organosiloxane by hydrolysis-condensation of a precursor silane compound represented by the formula described in col. 6, lines 42-43, optionally, in the presence of other hydrolyzable silanes. The R" and R"' can be methylene and alkoxy radicals, respectively. (col. 5, lines 5-65, col. 6, line 28 to col. 7, line 23 and Examples) Notably, the hydrolysis reaction is indeed performed in the presence of water. For Claim 16, Fekete does not explicitly mention the reaction temperature. As such, conventionally, the reaction temperature is construed as room temperature (i.e. about 25^{o}C). For Claims 21-24, the phosphonate-modified organosiloxane can be in the form of resins that clearly possess elastomeric properties. (col. 7, lines 16-23) Notably, "antistatic additive" is merely an intended use. Alternatively, as the phosphonate-modified organosiloxane and the claimed one are substantially the same, both should have the same antistatic property.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 14-15, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fekete.

Fekete discloses a process for preparing a phosphonate-modified organosiloxane, *supra*, which is incorporated herein by reference.

For Claim 14-15 and 17, Fekete is silent on the specific use of a catalyst and an organic solvent. However, Fekete teaches that the foregoing hydrolysis and condensation techniques are known to those skilled in the art of silicon chemistry. (col. 6, line 71 to col. 7, line 15) Furthermore, Examiner takes the Official notice that the employment of a) a catalyst and b) the claimed organic solvent in the hydrolysis and condensation of hydrolyzable silanes. Both are well within the skill of one of ordinary skill in the art for facilitating the hydrolysis and condensation.

For Claims 19-20, the phosphonate-modified organosiloxane can be in the form of **linears** and **oils** as a **lubricant additive**. (Emphases added) (col. 7, lines 16-26) Notably, the precursor silane compound can be derived from chloromethyl(methyl)**diethoxy**silane, etc.(col. 5, lines 55-65) As such, when a hydrolyzable silane is copolymerized with the precursor silane compound, the hydrolyzable silane should clearly contain two hydrolyzable groups such as an alkyldialkoxysilane in order to result in a **linear** phosphonate-modified organosiloxane. Fekete is silent on the number of D units (corresponding to claimed p value) derived from the hydrolyzable silane or the number of units derived from the precursor silane compound (corresponding to claimed s value). However, the number of D units and that of units derived form the precursor silane compound would affect the **lubricity** of the lubricant, which are obviously Result-Effective variables. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a phosphonate-modified organosiloxane having whatever numbers of D units and the units derived from the precursor silane compound through routine experimentation in order to afford an lubricant additive imparting a desired lubricity to the lubricant.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
June 4, 2008

/Kuo-Liang Peng/

Primary Examiner, Art Unit 1796